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Serial Number: 10/695,663   Dkt: 2050.140US1
Filing Date: October 29, 2003
Title: System and method for providing triggered event commands via digital program insertion splicing

REMARKS

This responds to the Office Action dated March 20, 2008.

Claim 7 is amended, no claims are canceled, and no claims are added; as a result, claims 1-9 are now pending in this application.

Claim Amendments

The amendment to claim 7 is made merely for clarity and is not intended to limit the scope of equivalents to which any claim element may be entitled.

§103 Rejection of the Claims

Claims 1 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Safadi (U.S. Patent No. 6,487,721) in view of Ridderheim et al. (U.S. Patent No. 6,986,153).

Applicants respectfully submit that the rejection of claims 1 and 9 under 35 U.S.C. § 103 is defective for the reason that a person of ordinary skill in the relevant field starting with Safadi and Ridderheim would not have found the limitations of claims 1 and 9 obvious.

Applicable Law

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *See* M.P.E.P. §2142. To establish *prima facie* obviousness there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."[1]

Argument

Applicant believes that the issue of patentablity over Safadi and Ridderheim is best understood with regard to the limitations of claim 1.

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[1] *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___ , 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

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Claim 1 includes the following limitation:

a digital splicer which receives the message from the ad server, extracts the attached command and splices the command into a digital transport stream including program content,

The Office Action, in rejecting claim 1, contends that the limitation "digital splicer" in the above quoted claim language is taught/suggested by the "encoder/mux 120" as illustrated[2] below:

FIG. 3
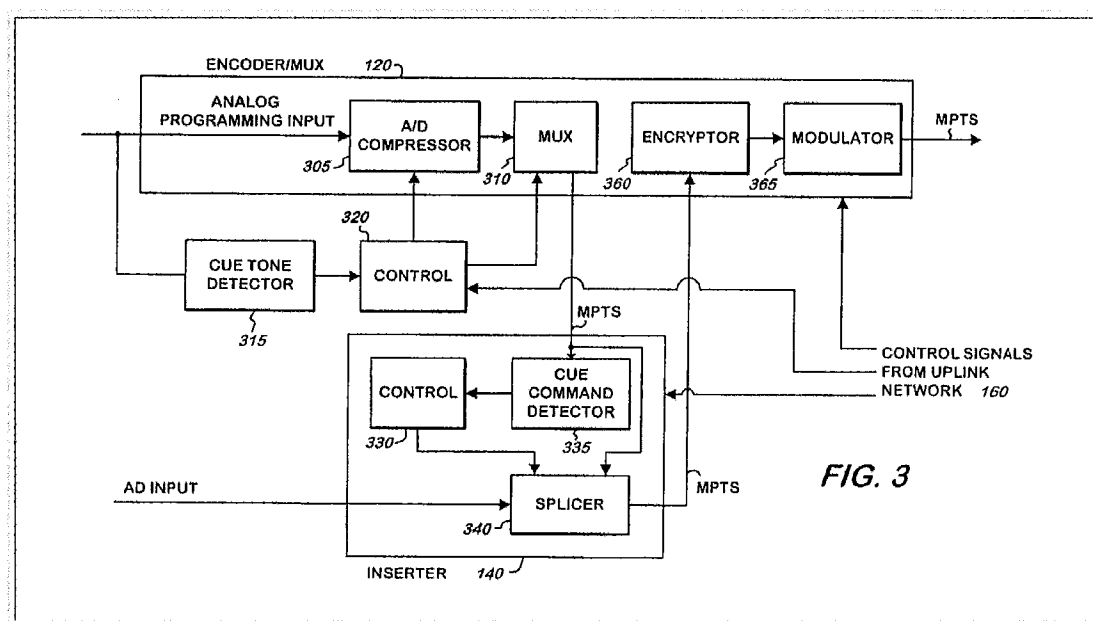
"The encoder / mux 120 receives an analog signal and encodes the analog signal as an spliceable MPEG-2 compressed stream.[3] The encoder / mux 120 further converts cue tones to cue commands that may be read by an inserter 140, 220. Safadi states:

The encoder/mux 120 encodes a given analog signal as a spliceable MPEG-2 compressed stream. If the input signal contains any cue tones, the encoder converts them to cue

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[2] Safadi., FIG.3
[3] Id. col. 6. lines 19-23.

commands that may later be used by the uplink inserter(s) 140 or the headend inserter(s) 220.[4]

The Office Action, in rejecting claim 1, further contends that the above limitation "receives a message" is taught/suggested by the following quote from Safadi:

> In response to such detection, a signal is provided to a control 320, which in turn generates a cue command message (e.g., a protocol message, that may span one or more MPEG-2 sections) and/or mux 310 for insertion into the digitized bit stream.[5]

The above quote from Safadi relates a cue command message (e.g., protocol message) that is communicated by a control 320 to convert cue tones to cue commands.

The Office Action, in rejecting claim 1, further contends that the phrase "extracts the attached command" in the above quoted claim language is taught/suggested by the following quote from Safadi:

> The control 320 can still cause a cue command to be inserted into the digital input at the mux 310, e.g., in response to a control signal received from the uplink network 160 or a local scheduler/controller or real-time trigger.[6]
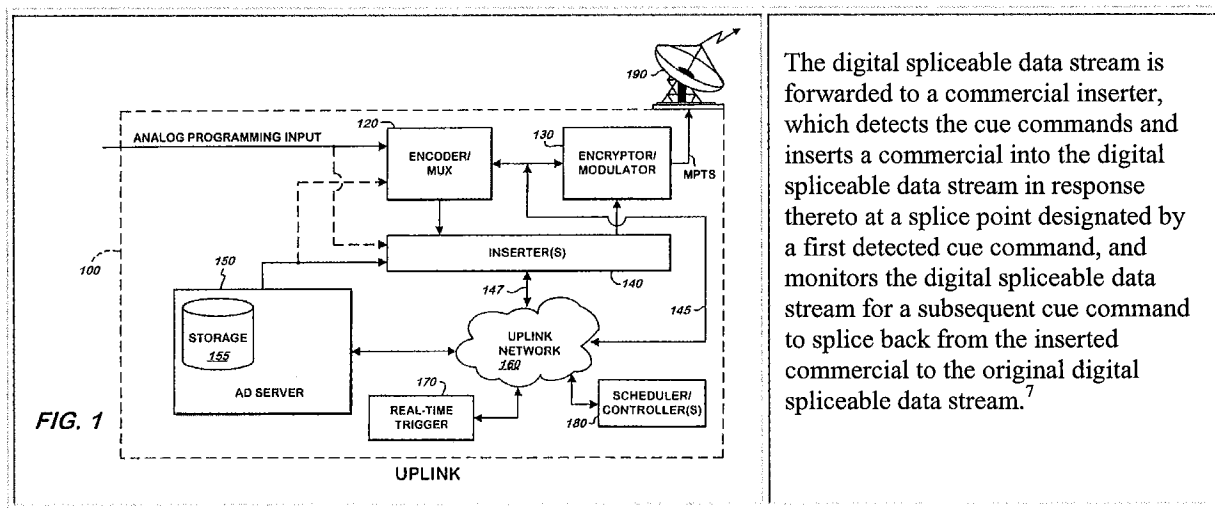
The above quote from Safadi relates to insertion of a cue command. Specifically, the control 320 can cause a cue command to be inserted into the digital input.

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[4] Id.
[5] Id. col. 8, lines 25-28.
[6] Id., col. 8, lines 25-28.

The following illustration and quote from Safadi may be relevant:

The digital spliceable data stream is forwarded to a commercial inserter, which detects the cue commands and inserts a commercial into the digital spliceable data stream in response thereto at a splice point designated by a first detected cue command, and monitors the digital spliceable data stream for a subsequent cue command to splice back from the inserted commercial to the original digital spliceable data stream.[7]

FIG. 1

The above FIG.1 illustrates a digital television uplink site 100 and includes the previously described encoder / mux 120. The digital television uplink site 100 receives an analog programming input which is processed by the encoder / mux 120. The encoder / mux 120 converts cue tones in the analog programming input to cue commands in a digital spliceable data stream (e.g., MPTS) and communicates the digital spliceable data stream to a commercial inserter 140. The commercial inserter 140 responds to a first cue command in the digital spliceable data stream by inserting a commercial into the digital spliceable data stream. The commercial inserter 140 continues to monitor the digital spliceable data stream for a subsequent cue command. The commercial inserter 140 responds to a subsequent cue command by splicing back from the inserted commercial to the original digital spliceable data stream.

Claim 1 requires a digital splicer which receives a message from an ad server, extracts the attached command and splices the command into a digital transport stream including program content. In contrast, the above quotes and illustrations from Safadi relate an encoder / mux 120 that communicates and receives a cue command message that is inserted into the digitized bit stream. Accordingly, Safadi fails to disclose a digital splicer, as required by the limitations of claim 1, much less a digital splicer that receives a message from an ad server.

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[7] Id., col. 3, lines 30-37.

Safadi fails to disclose a digital splicer that receives a message from an ad server in two respects. First, an encoder / mux is not a digital splicer. Indeed, Safadi relates a splicer 340 that processes a digital spliceable data stream and the splicer 340 operates [8] differently from the above described encoder / mux 120[9]. The above described encoder / mux 120 cannot be magically transformed into a digital splicer merely because it inserts a cue command into a digitized bit stream. To do so incorrectly exalts form over substance. Second, Safadi does not disclose a digital splicer that receives a message as required by the limitations of claim 1. Indeed, Safadi relates an encoder / mux 120 internally processing a cue command. Specifically, Safadi relates a mux 310 that receives a cue command message (e.g., protocol message) from a control 320. Albeit, Safadi illustrates the control 320 as outside the line delimiting the encoder / mux 120. Nevertheless, Safadi states, "If the input signal contains any cue tones, the _encoder_ converts them to cue commands ..."[10] Accordingly, Safadi does not disclose a digital splicer which receives a message from an ad server, as required by the limitations of claim 1. Rather, Safadi relates an encoder / mux 120 that internally processes a cue command.

Safadi further fails to disclose a digital splicer that extracts an attached command from a message. Safadi relates a control 320 that can cause a cue command message (e.g., protocol message) to be inserted into digital input in response to a control signal. Causing a cue command message (e.g., protocol message) to be inserted in response to a control signal is not the same as extracting an attached command from a message. Indeed, Safadi cannot possibly disclose the extraction of an attached command from a message because Safadi never discloses a message having an attached command, as required by the limitations of claim 1.

Broadly, Safadi relates an encoder / mux 120 that inserts cue commands into a digital spliceable data stream to enable a commercial inserter to insert a commercial into the digital spliceable data stream. The commercial inserter inserts a commercial into the digital spliceable data stream responsive to detecting a first cue command and splices back from the inserted commercial to the original digital spliceable data stream responsive to detecting a second cue command. Accordingly, Safadi relates an inserter that _monitors_ a digital spliceable data stream to identify cue commands that have _already been inserted_ into a digital spliceable data stream. In

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[8] Id.
[9] Id., col. 6, lines 18-23.
[10] Id. col. 6. lines 19-23 (emphasis added).

contrast, claim 1 requires a digital splicer which receives a message from an ad server, extracts the attached command and splices the command into a digital transport stream including program content. These are more than distinguishable features. These are fundamentally different systems.

Ridderheim relates an apparatus for local insertion of an analog or digital material into a television broadcast signal. Ridderheim also fails to disclose a digital splicer which receives a message from an ad server, extracts the attached command and splices the command into a digital transport stream including program content. Accordingly, Ridderheim cannot possibly provide what is lacking in Safadi. Indeed, a person having ordinary skill in the art would find significant differences between the references proffered and the invention of claim 1. Applicants respectfully submit that a person having ordinary skill in the art, having carefully considered Safadi and Ridderheim, would conclude the limitations of claim 1 are nonobvious.

Eldering

Claims 2-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Safadi (U.S. Patent No. 6,487,721) in view of Ridderheim et al. (U.S. Patent No. 6,986,153) as applied to claim 1 above, and further in view of Eldering et al. (U.S. Patent Application Publication No. 2002/0178445; hereinafter Eldering).

Claims 2-4 depend on independent claim 1. The cited patent to Eldering does not supply the elements of the independent claim 1 that were shown above to be missing from Safadi in combination with Ridderheim. If an independent claim is not obvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 2-4 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, a person in the relevant field and of ordinary skill who considers Eldering, whether separately of in combination with Safadi and/or Ridderheim, would not have found the limitations of independent claim 1 to be obvious as is required to support a *prime facie* case of obviousness in rejecting of the independent claims of the present application under 35 U.S.C.§ 103.

Examiner's Allegation that Applicants' Conceded Prior Art

Claims 5-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Safadi (U.S. Patent No. 6,487,721) in view of Ridderheim et al. (U.S. Patent No. 6,986,153) and Eldering et al. (U.S. Patent Application Publication No. 2002/0178445), as applied to claim 2 above, and further in view of Examiners allegation that Applicants' conceded prior art.

Claims 5-6 depend on independent claim 1. The Examiner's allegation of conceded prior art does not supply the elements of the independent claim 1 that were shown above to be missing from Safadi in combination with Ridderheim in combination with Eldering. If an independent claim is not obvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 5-6 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, a person in the relevant field and of ordinary skill who considers the Examiner's allegation of conceded prior art, whether in combination with Safadi and/or Ridderheim and/or Eldering, would not have found the limitations of independent claim 1 to be obvious as is required to support a *prime facie* case of obviousness in rejecting of the independent claims of the present application under 35 U.S.C.§ 103.

Examiner's Allegation that Applicants' Conceded Prior Art

Claims 7-8 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Safadi (U.S. Patent No. 6,487,721) in view of Ridderheim et al. (U.S. Patent No. 6,986,153) as applied to claim 1 above, and further in view of Examiner's allegation of Applicant's conceded prior art.

Claims 7-8 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Safadi (U.S. Patent No. 6,487,721) in view of Ridderheim et al. (U.S. Patent No. 6,986,153) and Eldering et al. (U.S. Patent Application Publication No. 2002/0178445), as applied to claim 1 above, and further in view of Examiners allegation that Applicants' conceded prior art.

Claims 7-8 and 10 depend on independent claim 1. The Examiner's allegation of conceded prior art does not supply the elements of the independent claim 1 that were shown above to be missing from Safadi in combination with Ridderheim. If an independent claim is not obvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 7-8 and 10 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, a person in the relevant field and of ordinary skill who considers the Examiner's allegation of conceded prior art, whether considered separately of in combination with Safadi and/or Ridderheim, would not have found the limitations of independent claim 1 to be obvious as is required to support a *prime facie* case of obviousness in rejecting of the independent claims of the present application under 35 U.S.C.§ 103.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 408-278-4041 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date _May 13, 2008_   By _/ Mark R. Vatuone /_

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